

RESPONSE AND REMARKS

The Examiner organized the Office action by numbered topics. In this Response, responsive measures refer to the Office action topic numbers with the abbreviation "OA Topic #."

DRAWINGS

In the Office Action (Topic Number 3), the Examiner stated that "[t]he proposed drawing correction filed 14 September 2004 has been approved." Accordingly, replacement formal drawings for drawings 10A, 10B, 10C, 10D, 10E, 24, 25, 27A, 27B, 27C, 30, 31, 32, 33A, 33B, 36A, 36B, 36C, 36D, 36E, 36F, 37A, 37B, 39A, 39B, 39C, 43, 64A-1, 64A-2, 64B-1, 64B-2, 65A, 65B, and 72 are submitted herewith.

SPECIFICATION

In the Office Action (Topic Number 5(A)(1)(a)), the Examiner objected to the specification regarding element 3026 (of FIGS. 36C and 36D), if the answer to the inquiry at test 3026 is "No". It is respectfully submitted that the specification describes the path to step 3028 when the answer to test 3026 is "No" in that, in paragraph [0291] of the substitute specification at page 56, line 26 through page 57, line 12, the specification states:

1) determine if the particular carrier supports the given billing option based on step 2, 3026. If not, continue with the next carrier 3027; 2) Apply carrier business rules . . . (If the rate input violates carrier business rules 3026, continue to next carrier 3027); 3) Determine the zone ID from CarrierZone table for the given origin/destination postal codes 3028...

It is respectfully submitted that the 3028 path for a "No" answer to the 3026 test is implicit in the above-cited disclosure in the specification of process 3028 to "Determine the zone ID...". Further, it is respectfully submitted that the disclosure of an application as filed includes the disclosure of a drawing in an application as filed. See, e.g., *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 866 (Fed. Cir. 1993) ("[D]rawings alone may provide a 'written description' of an invention as required by §112."); *In re Wolfensperger*, 302 F.2d 950, 955 (CCPA 1962). Even so, because amending the words of the

specification to conform to originally filed drawings does not constitute adding new matter (See In re Wolfensperger, 302 F.2d at 955 ("Patent Office Rule 118 authorizes, by implication at least, the amendment of the words in the written specification so as to add statements not originally contained in it to conform to originally filed drawings... without violation of the statute and rule which prohibit 'new matter.'")), an amendment to paragraph [0291] of the substitute specification has been submitted above to more distinctly describe the "no" path from process 3026.

In the Office Action (Topic Number 5(A)(1)(b)), the Examiner objected to the specification regarding the "No" answer logic flow path to the inquiries of elements 1163, 1168, 1169, 1172, and 1175 of FIG. 39B. It is respectfully submitted that the referenced "No" paths are implied in the specification as follows: the 1163 "No" path is implied in paragraph [0311] of the substitute specification via the discussion of the 1163 "No" path, namely, test 1168; the 1168 "No" path is implied in paragraph [0313] of the substitute specification via the discussion of test 1169, which is the test that is performed for the 1168 "No" path; the 1169 "No" path is implied in paragraph [0315] of the substitute specification via the discussion of test 1172, which is the test that is performed for the 1169 "No" path; the 1172 "No" path is implied in paragraph [0317] of the substitute specification via the discussion of test 1175, which is the test that is performed for the 1172 "No" path; and the 1175 "No" path is implied in paragraph [0319] of the substitute specification via the discussion of Next 1179, which is the step that is performed for the 1175 "No" path.

Further, it is respectfully submitted that the disclosure of an application as filed includes the disclosure of a drawing in an application as filed. See, e.g., Wang Laboratories, Inc. v. Toshiba Corp., 993 F.2d at 866 ("[D]rawings alone may provide a 'written description' of an invention as required by §112."); In re Wolfensperger, 302 F.2d at 955. Even so, because amending the words of the specification to conform to originally filed drawings does not constitute adding new matter (See In re Wolfensperger, 302 F.2d at 955), amendments to paragraphs [0311], [0313], [0315], [0317], and [0319] of the substitute specification have been submitted above to more distinctly describe the "no"

paths from processes 1163, 1168, 1169, 1172, and 1175.

In the Office Action (Topic Number 5(A)(1)(b)), the Examiner objected to the specification regarding the "No" answer logic flow path to the inquiries of elements 1180, 1184, 1187, and 1190 of FIG. 36C. It is respectfully submitted that the referenced "No" paths are implied in the specification as follows: the 1180 "No" path is implied in paragraph [0321] via the discussion of test 1184, which is the test that is performed for the 1180 "No" path; the 1184 "No" path is implied in paragraph [0323] via the discussion of test 1187, which is the test that is performed for the 1184 "No" path; the 1187 "No" path is implied in paragraph [0325] via the discussion of test 1190, which is the test that is performed for the 1187 "No" path; and the 1190 "No" path is implied in paragraph [0325] via the discussion of proceeding with the next Carrier/Service in the delivery rate set 1157 "[i]f the particular Carrier/Service does not support "Loss Protection" services...".

Further, it is respectfully submitted that the disclosure of an application as filed includes the disclosure of a drawing in an application as filed. See, e.g., Wang Laboratories, Inc. v. Toshiba Corp., 993 F.2d at 866 ("[D]rawings alone may provide a "written description" of an invention as required by §112."); In re Wolfensperger, 302 F.2d at 955. Even so, because amending the words of the specification to conform to originally filed drawings does not constitute adding new matter (See In re Wolfensperger, 302 F.2d at 955), amendments to paragraphs [0321], [0323], and [0325] of the substitute specification have been submitted above to more distinctly describe the "no" paths from processes 1163, 1180, 1184, 1187, and 1190.

In the Office Action (Topic Number 5(B)(1)), the Examiner objected to the specification regarding paragraph number 231. An amendment to paragraph number 231 has been submitted to resolve the Examiner's objection.

In the Office Action (Topic Number 5(B)(2)), the Examiner objected to paragraph 291 of the specification on grounds that the specification description of inquiry 3026 at lines 2-3 of paragraph 291 appeared inconsistent with the specification description of inquiry 3026 at lines 8-10 of paragraph 291 and regarding labeling of FIGS. 36C and 36D relevant to inquiry 3026.

In response to the Examiner's objection, an amendment to the specification has been submitted herewith and the following remarks are provided. As amended, the specification description in paragraph 291 at lines 27-28 of page 56 of the substitute specification now reads "1) determine if the particular carrier supports the given billing option based on step 2) (through 3026). If not, continue with the next carrier 3027...". It is respectfully noted that Step 2) (through 3026) referred to in paragraph 291 at lines 27-28 of page 56 of the substitute specification appears at page 56, line 28 through page 57, line 4, and specifies: "2) Apply carrier business rules, including: a) Calculate dimensional weight 3023; b) Determine billable weight 3024: actual weight, dimensional weight, oversize weight or letter weight; c) Validate package weight and dimensions 3025; (If the rate input violates carrier business rules 3026, continue to next carrier 3027)...". It is respectfully submitted that the test as to whether a particular carrier *supports the given billing option* based on step 2 (through 3026) is not inconsistent with the specification description of inquiry 3026 at lines 3-4 of page 57 and the label of inquiry 3026, that describes the 3026 test as testing whether a particular package weight and dimensions *violate carrier business rules*.

SECTION 112

In the Office Action (Topic Number 7), the Examiner rejected Claims 1-10, 12-49, and 51-53 on various grounds under 35 U.S.C. §112, second paragraph on various grounds.

Claims 1-3, 9, 17, 20-21, 24, 26, 32, 37-41, 46-48, and 53 have been cancelled; amendments to Claims 4-8, 10-16, 18-19, 22-23, 25, 27-31, 33-36, 42-45, and 49-52 to more distinctly claim the claimed invention are filed concurrently herewith. It is respectfully submitted that the amendments to Claims 4-8, 10-16, 18-19, 22-23, 25, 27-31, 33-36, 42-45, and 49-52 resolve the Examiner's rejection of those Claims under Section 112.

SECTION 101

In the Office Action (Topic Number 8), the Examiner rejected Claims 1-21 and 23-53 under 35 U.S.C. § 101 on various grounds.

Claims 1-3, 9, 17, 20-21, 24, 26, 32, 37-41, 46-48, and 53 have been cancelled; amendments to Claims 4-8, 10-16, 18-19, 22-23, 25, 27-31, 33-36, 42-45, and 49-52 to more distinctly claim the claimed invention are filed concurrently herewith. It is respectfully submitted that the amendments to Claims 4-8, 10-16, 18-19, 22-23, 25, 27-31, 33-36, 42-45, and 49-52 resolve the Examiner's rejection of those Claims under Section 101.

SECTION 102 REJECTIONS

In the Office Action (Topic Number 9.2), the Examiner rejected Claims 1-5, 11-34, 36-47, 49 and 50 under 35 U.S.C. § 102(a) as being anticipated by a PR Newswire release by WorldWide Merchant regarding InterShipper 4.0. In the Office Action, the Examiner referred to this reference as "TEMPE"; it is referred to herein as "InterShipper".

In the Office Action (Topic Number 9.1), the Examiner also rejected Claims 1-5, 11-34, 36-47, 49 and 50 under 35 U.S.C. § 102(b) as being anticipated by a PR Newswire release by TanData, reflecting a date of July 21, 1997. In the Office Action, the Examiner referred to this reference as "TULSA"; it is referred to herein as "TanData". In the Office Action (Topic Number 9.1), the Examiner also rejected Claims 1-5, 11-34, 36-47, 49 and 50 under 35 U.S.C. § 102(b) as being anticipated by Thiel, U.S. Patent No. 5,699,258 ("Thiel").

In OA Topic 9.3 of the Office Action, the Examiner also rejected Claims 1-5, 11-34, 36-47, 49 and 50 under 35 U.S.C. § 102(e) as being anticipated by Barton, U.S. Patent Application Publ'n No. US 2002/0022983 (Serial No. 09/873,756) ("Barton").

The Examiner's rejections of the Claims under Section 102 have been carefully considered. Claims 1-3, 9, 17, 20-21, 24, 26, 32, 37-41, 46-48, and 53 have been cancelled; amendments to Claims 4-8, 10-16, 18-19, 22-23, 25, 27-31, 33-36, 42-45, and 49-52 to more distinctly claim the claimed invention are filed concurrently herewith. It is respectfully submitted that none of cited

references, whether considered alone or in combination with each other, disclose, teach or suggest all of the limitations of amended Claims 4-8, 10-16, 18-19, 22-23, 25, 27-31, 33-36, 42-45, and 49-52 of the present application. Further responsive remarks regarding some of amended Claims 4-8, 10-16, 18-19, 22-23, 25, 27-31, 33-36, 42-45, and 49-52 and the Examiner's rejections under Section 102 are provided below.

SECTION 103 REJECTIONS

In the Office Action (Topic Number 10), the Examiner rejected Claims 6-8 and 48 under 35 U.S.C. § 103(a) as being unpatentable over either TanData, or Thiel, or Intershipper, or Barton as applied to Claims 1-5, 11-34, 36-47, 49 and 50 and further in view of "an obvious modification for customer service" Office Action, Topic 10.1, page 19. The Examiner stated that "although neither TULSA nor Thiel ('258) nor TEMPE nor Barton ('983) disclose using user preferences, it would have been obvious to one of ordinary skill at the time the invention was made that the shipping systems of either TULSA or Thiel ('258) or TEMPE or Barton ('983) could be modified to record the user's preferences for shipping services, since it would be good customer service to not require a frequent user to constant[ly] re-enter shipping/payment information each time the user used the shipping system." Office Action, Topic 10.1.1, page 19.

The Examiner rejected Claims 35 and 51 under 35 U.S.C. § 103(a) as being unpatentable over either TanData, or Thiel, or Intershipper, or Barton as applied to Claims Claims 1-8, 11-34, 36-50 and further in view of "an obvious modification in view of the need of the customer." Office Action, Topic 10.2, page 19. The Examiner stated that "it would have been obvious to one of ordinary skill at the time the invention was made that the user of the systems of either TULSA or Thiel ('258) or TEMPE or Barton ('983) could also consider[] the delivery times when selecting a carrier." Office Action, Topic 10.2.1, pages 19-20.

The Examiner rejected Claims 52 and 53 under 35 U.S.C. § 103(a) as being unpatentable over either TanData, or Thiel, or Intershipper, or Barton as applied to Claims 1-8, and 11-51 and further in view of "an obvious modification in view of the need of the customer." Office Action, Topic 10.3, page 20. The

Examiner stated that "it would have been obvious to one of ordinary skill at the time the invention was made that the shipping systems of either TULSA or Thiel ('258) or TEMPE or Barton ('983) could be modified to print shipping labels, since most carriers require the user to pre-address the item before the carrier accepts the item for shipping." Office Action, Topic 10.3.1, page 20.

The Examiner rejected Claims 9 and 10 under 35 U.S.C. § 103(a) in view of as being unpatentable over either TanData, or Intershipper, or Barton as applied to Claims 1-8, and 11-53 and further in view of "an obvious modification in view of the system's operation." Office Action, Topic 10.4, page 20. The Examiner stated that "it would have been obvious to one of ordinary skill at the time the invention was made that the internet based shipping systems of either TULSA or TEMPE or Barton ('983) would use hyper links to permit the user to move from one location to another location or from one web page to another as is common in internet based systems." Office Action, Topic 10.4.1, page 20.

The Examiner's rejections of the Claims under Section 103 have been carefully considered. Claims 1-3, 9, 17, 20-21, 24, 26, 32, 37-41, 46-48, and 53 have been cancelled; amendments to Claims 4-8, 10-16, 18-19, 22-23, 25, 27-31, 33-36, 42-45, and 49-52 to more distinctly claim the claimed invention are filed concurrently herewith. Responsive remarks regarding the amended Claims and the Examiner's rejections under Section 103 are provided below.

It is respectfully submitted that none of cited references, whether considered alone or in combination with each other, disclose, teach or suggest all of the limitations of amended Claims 4-8, 10-16, 18-19, 22-23, 25, 27-31, 33-36, 42-45, and 49-52 of the present application. Further responsive remarks regarding some of amended Claims 4-8, 10-16, 18-19, 22-23, 25, 27-31, 33-36, 42-45, and 49-52 and the Examiner's rejections under Section 103 are provided below.

RESPONSIVE REMARKS REGARDING SECTION 102 AND 103 REJECTIONS

With regard to Claims 6-8, and 48, the basis for the rejection under Section 103(a) is respectfully traversed. The Examiner rejected Claims 6-8 and 48 based on the reasoning that "it would have been obvious to one of ordinary

skill at the time the invention was made that the shipping systems of either TULSA or Thiel ('258) or TEMPE or Barton ('983) could be modified to record the user's preferences for shipping services, since it would be good customer service to not require a frequent user to constant[ly] re-enter shipping/payment information each time the user used the shipping system " (Office Action, Topic 10.1, pages 19-20). It is respectfully submitted that the Examiner's reasoning does not establish *prima facie* obviousness because there is no disclosure, teaching, suggestion or motivation in the cited references of receiving user-specified preferences for a plurality of users.

Still further, as explained further below, Claims 6-8 are directed to a shipping management computer system involving both a first user and a second user. For example, Claim 6, as amended, is directed to "receiving, from a first computer device, a set of itemized charge presentation preferences, wherein said itemized charge presentation preferences: (A) have been defined by a *first user*, and (B) identify a plurality of shipping charge options to be presented to one or more users ... and using the itemized charge presentation preferences to generate a display on a display device that is in communication with a second computer device used by a *second user*..." None of the cited references, alone or in combination, even suggest a motivation for receiving information from a first user for display to a second user.

With regard to Claims 35 and 51, the basis for the rejection under Section 103(a) is respectfully traversed. The Examiner rejected Claims 35 and 51 based on the reasoning that "it would have been obvious to one of ordinary skill at the time the invention was made that the user of the systems of either TULSA or Thiel ('258) or TEMPE or Barton ('983) could also consider[] the delivery times when selecting a carrier." Office Action, Topic 10.2, page 20.

With respect to the rejection of Claim 35 under section 103(a), it is respectfully submitted that the Examiner's reasoning does not establish *prima facie* obviousness because there is no teaching, suggestion or motivation in the cited references of " identifying a plurality of carriers that would support shipping the respective parcel according to the origin identifier, the delivery destination

identifier, and the set of parcel specifications ..." (as recited in Claim 35, as amended).

Further, with respect to the rejection of Claim 51 under section 103(a), it is respectfully submitted that the Examiner's reasoning does not establish *prima facie* obviousness because there is no teaching, suggestion or motivation in the cited references of:

(a) determining a first delivery schedule according to which said particular parcel would be delivered from said origin postal code to said destination postal code if said particular parcel were shipped on said shipping date by a first carrier via a first delivery service;

(b) determining a second delivery schedule according to which said particular parcel would be delivered from said origin postal code to said destination postal code if said particular parcel were shipped on said shipping date by said first carrier via a second delivery service;

(c) determining a third delivery schedule according to which said particular parcel would be delivered from said origin postal code to said destination postal code if said particular parcel were shipped on said shipping date by a second carrier via a first delivery service;

(d) determining a fourth delivery schedule according to which said particular parcel would be delivered from said origin postal code to said destination postal code if said particular parcel were shipped on said shipping date by said second carrier via a second delivery service ...

(as recited in amended Claim 51).

With regard to Claim 52, the basis for the rejection under Section 103(a) is respectfully traversed. The Examiner rejected Claim 52 based on the reasoning that "it would have been obvious to one of ordinary skill at the time the invention was made that the shipping systems of either TULSA or Thiel ('258) or TEMPE or Barton ('983) could be modified to print shipping labels, since most carriers require the user to pre-address the item before the carrier accepts the item for shipping." Office Action, Topic 10.3.1, page 20.

With respect to amended Claim 52, it is respectfully submitted that the Examiner's reasoning does not establish *prima facie* obviousness because there is no teaching, suggestion or motivation in the cited references for "...identifying a set of graphic resolution characteristics associated with a remote display device configured with said user client computer device..." (as recited in amended Claim 52).

With regard to Claim 10, the basis for the rejection under Section 103(a) is respectfully traversed. The Examiner rejected Claim 10 based on the reasoning that "it would have been obvious to one of ordinary skill at the time the invention was made that the internet based shipping systems of either TULSA or TEMPE or Barton ('983) would use hyper links to permit the user to move from one location to another location or from one web page to another as is common in internet based systems." Office Action, Topic 10.4.1, page 20.

With respect to amended Claim 10, it is respectfully submitted that the Examiner's reasoning does not establish *prima facie* obviousness because there is no teaching, suggestion or motivation in the cited references for "...creating a hypertext link template comprising at least one variable data field and at least one global communications address field; populating the at least one variable data field in the hypertext link template with the at least one item of data input by the first user; populating at least one global communications address field in the hypertext link template with a universal address location corresponding to an address at which program instructions are located for processing the at least one item of data in the at least one variable data field; [and] creating a hypertext link to the universal address location, wherein the hypertext link comprises: (A) the universal address location; and (B) the at least one variable data field, said at least one variable data field being populated with the at least one item of data..." (as recited in amended Claim 10).

With respect to Claims 4-8, 10-12, 16, 18-19, and 30, it is respectfully submitted that none of the cited references, whether considered alone or in combination with any other reference of record, disclose, teach or suggest a computer system, such as a shipping management computer system, directed for interaction, as claimed, with both a first user and a second user, or as claimed in Claim 10, between a first user and a plurality of users.

For example, amended Claim 4 is directed to "[a] shipping management computer system ... programmed for: receiving, via a first computer device, an input of a subset of carriers that have been selected by a *first user* from a plurality of carriers and designated as acceptable carriers by the *first user*, [and] displaying the subset of carriers to a display device that is in communication with

a second computer device used by a *second user* ..."

As an exemplary context for claims that use input from both a first user and a second user, or use input from a first user for presentation to a second user, the specification of the present application describes an exemplary "eCommerce/eAuction" embodiment. See, e.g., Substitute Specification, page 13, lines 8-10 ("... in the exemplary eCommerce embodiment of the invention, the System prompts different individuals to provide information necessary to rate and ship a particular parcel.").

It is respectfully submitted that none of the cited references, whether considered alone or in combination with any other reference of record, disclose, teach or suggest a shipping management computer system directed for interaction, as claimed, with both a first user and a second user, or as claimed in Claim 10, between a first user and a plurality of users. Accordingly, it is therefore respectfully submitted that amended Claims 4-8, 10-12, 16, 18-19, and 30 are patentable over the cited references, whether considered alone or in combination with any other reference of record.

With respect to Claims 13-15, 22, 23, and 25, it is respectfully submitted that none of the cited references, whether considered alone or in combination with any other reference of record, disclose, teach or suggest all of the limitations of Claims 13-15, 22, 23, and 25, all of which are directed in one way or another to tracking of parcel shipping.

For example, it is respectfully submitted that none of the cited references, whether considered alone or in combination with any other reference of record, disclose, teach or suggest all of the limitations of Claim 14 which is directed to "[a] shipping management computer system that is programmed for ... using the system-generated tracking number to identify the carrier-specific tracking number..."

CONCLUSION

For all the foregoing reasons, it is respectfully submitted that none of cited references, whether considered alone or in combination with each other,


disclose, teach or suggest all of the limitations of amended Claims 4-8, 10-16, 18-19, 22-23, 25, 27-31, 33-36, 42-45, and 49-52 of the present application.

For all of the foregoing reasons and authorities, it is therefore respectfully submitted that amended Claims 4-8, 10-16, 18-19, 22-23, 25, 27-31, 33-36, 42-45, and 49-52 of the present application are patentable over the cited references.

In view of the foregoing amendments, and for the foregoing reasons and authorities, Applicant respectfully submits that the invention disclosed and claimed in the present application as amended is not fairly taught by any of the references of record, taken either alone or in combination and that the application is in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and allowance of the application as reflected in the substitute specification and in the Claim amendments concurrently filed herewith.

Respectfully submitted,

KHORSANDI PATENT LAW GROUP, ALC

By 
Marilyn R. Khorsandi
Reg. No. 45,744
626/796-2856